UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,500	07/15/2005	Gerfried Ranner	282594US8XPCT	5322

22850 7590 10/01/2007		EXAMINER
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ART UNIT	PAPER NUMBER
2131	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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	Application No.	Applicant(s)
Office Action Summary	10/542,500	RANNER ET AL.
	Examiner	Art Unit	
	Longbit Chai	2131 .	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 September 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10,12-18,20,21,23-25 and 27-36</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10,12-18, 20,21,23-25 and 27-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>15 July 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Currently pending claims are 1 – 20 and 30 – 40.

Response to Arguments

2.   Applicant's arguments with respect to instant claims have been fully considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

3.   As per claim 1, Applicant asserts "Paolucci neither discloses nor suggest that the CD of Paolucci itself is copy protected. That is, if a third party obtained or reproduced the confidential character code, Paolucci neither discloses nor suggests that third party couldn't copy the programs from the CD of Paolucci onto another program (Remarks: Page 14)". Examiner respectfully disagrees. Examiner notes the claim is given its broadest interpretation based upon MPEP §2111, and a CD that stores user information (e.g., 5-character confidential code and etc.) in a secure manner by making it impossible to be reproduced without authentication is considered as one type of copy protected record carriers. Therefore, Applicant's argument has no merit since the alleged limitation (e.g., if a third party obtained or reproduced the confidential character code, the third party couldn't copy the programs from the CD) has not been recited into the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4.   As per claim 1, Applicant asserts Raja fails to disclose or suggest "automatically initiating and confirming, by the authentication server, using information contained in the record carrier, a connection between a computer and the predetermined area of the target server". Examiner respectfully disagrees because (a) Raja reference is relied upon to provide automatically

initiating and confirming, by the authentication server, <u>using information received</u> by the authentication server (Raja: Column 12 Line Line 12 – 17 / Line 1 – 2 & Figure 3 / Element 330 & 157) and <u>each user identifier being related to a different desired target location</u> (Raja: Column 6 Line 40 – 42 / Line 63 – 65: Examiner notes this <u>user identifier</u> is thus also qualified as a <u>project ID</u>) and (b) Paolucci reference is relied upon providing the required information (such as <u>user identifier</u>) that can be stored / burned into the CD (Paolucci: Page 5 Line 1 – 5, Page 6 Line 1 – 2 / Line 12 – 13 and Page 7 Line 1). Therefore, Raja in view of Paolucci does teach "automatically initiating and confirming, by the authentication server, using information contained in the record carrier, a connection between a computer and the predetermined area of the <u>target server that is identified by the project ID</u>" and as such Applicant's arguments are respectfully traversed.

5.   As per claim 1, Applicant asserts Paolucci and Raja fail to disclose or suggest features of "verifying, by said authentication server, whether a changing parameter of the computer, which is a randomly generated number or a computer system time transmitted from said computer, was previously used (Remarks: Page 16)". Examiner respectfully disagrees because the <u>one-time password</u>, as taught by Robinson (or Greene), is indeed <u>a changing authentication parameter</u> of the computers used between the transaction parties, which is also a randomly generated number and <u>was not previously used</u> for authentication to meet the claim language, as recited in claim 1.

6.   As per claim 16, Applicant asserts Paolucci fails to disclose "the predetermined email URL address website is on the CD (Remarks: Page 17 / 4th Para / Line 3 – 4)". Examiner notes the claim limitation does not recite at all regarding "the predetermined email URL address website is on the CD" – according to base claim 5, it is only recited as "using <u>information contained in the record carrier</u>"; however, it does not recites exactly what kind of information

contained in the record carrier is used. Therefore, Applicant's argument has <u>no merit</u> since the alleged argument (e.g., he predetermined email URL address website is on the CD) has neither been recited into the claim nor is supported by the disclosure of the instant specification at all – please note <u>a predetermined area does not mean a particular area inside the CD, according to the specification</u>.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 16 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 16 and 28, the use of the claim language "<u>bonus material related to the content</u>" renders these claims indefinite, since there is no idea at all about what exactly <u>the content</u> that Applicant is intended to refer to.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1 – 10, 12, 13, 15 – 18, 20, 21, 23 – 25 and 27 – 36 are rejected under 35 U.S.C.

103(a) as being unpatentable over Paolucci et al. (Frence Patent FR-A-2822255), in view of

Rajakarunanayake (U.S. Patent 6,587,883, and in view of Robinson et al. (U.S. Patent

2004/0034767).

        As per claim 1, 5, 18 and 20, Paolucci teaches a method for **securing an access to a**

predetermined area of a target server (Paolucci: Page 5 Line 1 – 3, Page 10, 2nd Para and

Page 17, 3rd Bullet: enabling a secure access to a specific internet website (i.e. a predetermined

area of a target server) from a CD), the method comprising:

        providing an information file on a copy protected record carrier (Paolucci: Page 6,

2nd Para, 1 – 4 Bullets, Page 10 Line 1 – 2, Page 16, 2nd – 5th Para, Page 17, 3rd Bullet, Page 7

Line 1 and Page 9, 1st Para / 3rd Para: a CD that stores user information (e.g., 5 -character

confidential code and etc.) in a secure manner by making it <u>impossible to be reproduced</u> is

considered as one type of copy protected record carriers and the stored user information

allowing a user to automatically access and launch an internet connection request is considered

as an information file), **information file comprising a project identifier or an address of an**

authentication server with which an application using said information file can

communicate (Paolucci: Page 7 Line 1, Page 15 Line 6 – 8, Page 17, 3rd Bullet, Page 10, 2nd

Para, Page 9, 1st Para / 3rd Para, Page 14 Line 5 – 7 and Page 6, Last 2nd Bullets: (a) the

information regarding the application enabling a secure access to a specific internet website is

stored on the CD (b) the user's confidential access code to access a specific internet website is

considered as part of a project identifier and (c) the stored information to automatically launch

the internet connection request to access specific internet website and to validate the authorized

opening session with 5 characters confidential code is considered as part of information to communicate with an authentication server).

However, Paolucci does not disclose expressly automatically initiating and confirming, by the authentication server using information contained in the record carrier, a connection between a computer on which said application is started and said predetermined area of said target server that is identified by the address of the authentication server or the project identifier.

Rajakarunanayake in view of Paolucci teaches **automatically initiating and confirming, by the authentication server using information contained in the record carrier, a connection between a computer on which said application is started and said predetermined area of said target server that is identified by the address of the authentication server or the project identifier** (Rajakarunanayake: Column 12 Line Line 12 – 17 / Line 1 – 2 & Figure 3 / Element 330 & 157 and Column 6 Line 40 – 42 / Line 63 – 65: (a) Raja reference is relied upon to provide automatically initiating and confirming, by the authentication server, using information received by the authentication server (Raja: Column 12 Line Line 12 – 17 / Line 1 – 2 & Figure 3 / Element 330 & 157) and each user identifier being related to a different desired target location (Raja: Column 6 Line 40 – 42 / Line 63 – 65: Examiner notes this user identifier is thus also qualified as a project ID) and (b) Paolucci reference is relied upon providing the required information (such as user identifier) that can be stored / burned into the CD (Paolucci: Page 5 Line 1 – 5, Page 6 Line 1 – 2 / Line 12 – 13 and Page 7 Line 1). In summary, an Authentication server is used to provide a secure connection to a secure target location and the user identifier (i.e. authentication information) is used by the Authentication server to uniquely identify the desired target location and once the desired target location is determined (i.e. after the positive verification of the user identifier and authentication information by the authentication server), a new session is established between the user and

the determined target location by the authentication server – i.e., there are two sections: one

session between the clients and the authentication server and subsequently a new session is

started between the clients and the target system (ISP)).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teaching of Rajakarunanayake within the system of

Paolucci because (a) Paolucci teaches providing an automated secured access to a target

location (i.e. internet website) by launching of the process from a user's CD at the client site and

authenticating with the target system for the open session connection (Paolucci : Page 2 Line 1

– 2 and Page 6, 5th Bullet), and (b) Rajakarunanayake teaches using an authentication server to

establish a new secured session between the user and the determined target location while the

connectivity is disabled to other target locations so that the desired target system at the secure

location may not be exposed to the risk of unauthorized access (Rajakarunanayake: Column 12

Line 1 – 2 / Line 12 – 17 & Figure 3 / Element 330 & 157 and Column 2 Line 7 – 10).

Paolucci as modified does not disclose expressly said authentication server

verifies whether or not a changing parameter of the computer, which is a randomly

generated number or a computer system time transmitted from said computer, was

previously used and initiates a connection of said computer with said predetermined

area of said target in case of a positive verification.

Robinson teaches **verifying, by said authentication server, whether or not a**

changing parameter of the computer, which is a randomly generated number or a

computer system time transmitted from said computer, was previously used and initiates

a connection of said computer with said predetermined area of said target in case of a

positive verification (Robinson: Para [0075] and Para [0044]: the <u>on-time password</u>, as taught

by Robinson, is indeed <u>a time-based token authentication with dynamically changing</u>

authentication parameter of the computers used between the transaction parties, which is also a randomly generated number and was not previously used for authentication).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Robinson within the system of Paolucci as modified because (a) Paolucci teaches providing an automated secured access to a target location (i.e. internet website) by launching of the process from a user's CD at the client site and authenticating with the target system for the open session connection (Paolucci : Page 2 Line 1 – 2 and Page 6, 5th Bullet), and (b) Robinson teaches providing an one-time password to enhance the authentication technique since a previously valid password does not provide any information about the validity of subsequent passwords (Robinson: Para [0075] and Para [0044]).

As per claim 2, Paolucci as modified teaches automatically executing, after the record carrier is loaded in a reading device, a predetermined executable file provided in an autorun-information file on said record carrier (Paolucci: Page 7, Section of Auto-run mode, 1st Para and Page 7 Line 1: automatic launching of connection request upon the insertion of the CD).

As per claim 3 and 25, Paolucci as modified teaches automatically executing an autostart file provided on said record carrier, after the record carrier is placed and loaded in a reading device and which autostart file including (i) a link to start said application, (ii) an indication that autostart file is part of said application, or which autostart file is said information file (Paolucci: Page 7, Section of Auto-run mode, 1st Para, Page 17, 3rd Bullet and Page 7 Line 1 and Page 15 Line 6 – 8: automatic launching of connection request upon the insertion of the CD).

As per claim 4, Paolucci as modified teaches providing the application on said record carrier, or on a server, as a download, or on an access-software record carrier (Paolucci: Page 6, 2nd Para, 1st Bullet and Page 15 Line 6 – 8: Launching of the process in Auto-run mode from the CD).

As per claim 6, Paolucci as modified teaches starting the application from said record carrier, or from a server, preferably as a download, or via an access-software record carrier, preferably after an installation of the application on a hard disc of the computer (Paolucci: Page 6, 2nd Para, 1st Bullet and Page 17, 3rd Bullet: Launching of the process in Auto-run mode from the CD).

As per claim 7, 21 and 23, Paolucci as modified teaches said application verifies whether or not the record carrier is an original and performs said communication with said authentication server in case of a positive verification (Paolucci: Page 10 Line 1 – 2 & 2nd Para, Page 6, Last 2nd Para, Page 9, 1st Para and Page 17, 3rd Bullet: an access to a certain website is only possible by using the original CD because the information file (e.g., key / confidential access code, URL and password) integrated into a specific file enabling a secure access to the website is copy-protected (i.e. is impossible to be reproduced)) and as such, the communication with the authentication server cannot be started without the information file due to being copy-protected).

As per claim 8, Paolucci as modified teaches transmitting, by said application transmits a changing parameter of the computer, to said authentication server (Robinson: Column 1 Line 50 – 52 / Line 55 – 60: a one-time pad of passwords is synchronously changed and used between

the end-to-end parties and a previously valid password does not provide any information about the validity of subsequent passwords).

As per claim 9, Paolucci as modified teaches verifying, by said authentication server whether the communication with said application and/or a transmission of said project identifier as a request for a connection between said computer and said predetermined area of said target server is posted from said application, wherein said connection is initiated upon indication from said verifying step that the communication or the transmission of said project identifier is posted (Paolucci: Page 7 Line 1, Page 8, 2nd Para / Line 5 – 7 Page 9, 1st Para and Page 17, 3rd Bullet: between the access device and the authentication server) & (Rajakarunanayake: Column 12 Line 1 – 2 / Line 12 – 17 & Figure 3 / Element 330 & 157 and Column 2 Line 7 – 10: after the positive verification of the user identifier and authentication information by the authentication server, a new session is established between the user and the determined target location by the authentication server).

As per claim 10, Paolucci as modified teaches establishing a connection, upon indication from said verifying step that the changing parameter was not previously used, between said authentication server and said target server to connect that the computer to said predetermined area of said target server via said authentication server (Rajakarunanayake: Column 12 Line 1 – 2 / Line 12 – 17 & Figure 3 / Element 330 & 157 and Column 2 Line 7 – 10: after the positive verification of the user identifier and authentication information by the authentication server, a new session is established between the user and the determined target location by the authentication server).

As per claim 12, Paolucci as modified teaches:

the authentication server generates a session identifier based on the positive verified values and transmits said session identifier to said target server via said connection between said authentication server and said target server (Rajakarunanayake: Column 12 Line 1 – 2 / Line 12 – 17 & Figure 3 / Element 330 & 157 and Column 2 Line 7 – 10: after the positive verification of the user identifier and authentication information by the authentication server, a new session is established between the user and the determined target location by the authentication server),

said connection between said computer on which said application is started and said predetermined area of said target server is set up by redirecting the connection between the computer and the authentication server to the target server or by forwarding data of the protected area to the computer (Rajakarunanayake: Column 12 Line 1 – 2 / Line 12 – 17 & Figure 3 / Element 330 & 157 and Column 2 Line 7 – 10), and

said connection between said computer on which said application is started and said predetermined area of said target server is executed after the target server received a confirmation of a validity of the session identifier from the authentication server (Rajakarunanayake: Column 6 Line 63 – Column 7 Line 1 and Column 12 Line 1 – 2 / Line 12 – 17: when the user ends the session to the target location, the user need to be authenticated by the authentication server again – and therefore, Examiner notes the target server received a confirmation of a validity of the session identifier from the authentication server).

As per claim 13, Paolucci as modified teaches the authentication server confirms the validity of the session identifier by positively determining whether or not the session identifier exists and/or whether or not the session identifier was already requested to be valid (Robinson:

Para [0075] and Para [0044]: the on-time password, as taught by Robinson, is indeed a time-based token authentication with dynamically changing authentication parameter of the computers used between the transaction parties, which is also a randomly generated number and was not previously used for authentication).

As per claim 15, Paolucci as modified teaches copy protecting the information file to copy protect said record carrier (Paolucci: Page 10 Line 1 – 2 & 2nd Para, Page 6, Last 2nd Para, Page 9, 1st Para and Page 17, 3rd Bullet: key / confidential access code, URL and password integrated into a specific file, as part of the information file, enabling a secure access to an internet website is copy-protected (i.e. is impossible to be reproduced), as taught by Paolucci).

As per claim 16 and 28, Paolucci as modified teaches said predetermined area on said target server comprises bonus material related to the content (Paolucci: Page 19 / 2nd bullet – last line, Page 19 Last Para, Page 18 Last 2nd Para).

As per claim 17 and 27, Paolucci as modified teaches said information file is a part of said application or is an executable file of said application (Paolucci: Page 10 Line 4 – 6 / Line 10 – 11, Page 17, 3rd Bullet and Page 14 Line 6 – 7).

As per claim 24, Paolucci as modified teaches an autorun-information file, which provides an automatic execution of a predetermined executable file after the record carrier is loaded in a reading device (Paolucci: Page 7, Section of Auto-run Mode, Line 1 – 4: loaded from a CD reader as a reading device).

As per claim 29, 31, 33 and 35, Paolucci as modified teaches the information file comprises the project ID and the address of the authentication server (Paolucci: Page 6 Line 12 – 15 and Page 7 Line 1: the autorun mode automatically launching of the "connection request" based on the confidential code and a core software program burned on a CD – Examiner notes (a) "connection request" inherently involves authentication request for connection between the authentication server and the client and (b) the confidential code and a core software program burned on a CD must inherently be related to the address of the authentication server in order to automatically launching of the "connection request")

As per claim 30, 32, 34 and 36, Paolucci as modified teaches the changing parameter is randomly generated number and a computer system time (Robinson: Para [0075] and Para [0044]: the on-time password, as taught by Robinson, is indeed a time-based token authentication with dynamically changing authentication parameter of the computers used between the transaction parties, which is also a randomly generated number and was not previously used for authentication).

9.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paolucci et al. (Frence Patent FR-A-2822255), in view of Rajakarunanayake (U.S. Patent 6,587,883, and in view of Robinson et al. (U.S. Patent 2004/0034767), and in view of Mitchell et al. (U.S. Patent 6,959,420).

As per claim 14, Paolucci as modified does not disclose expressly the target server assigns a temporary session cookie to the computer so that the whole predetermined area of

the target server can be accessed via said connection between said computer on which said

application is started and said target server.

Mitchell teaches the target server assigns a temporary session cookie to the computer

so that the whole predetermined area of the target server can be accessed via said connection

between said computer on which said application is started and said target server (Mitchell:

Column 1 Line 28 – 35 / Line 43 – 45 / Line 56 – 60: a temporary or session cookie is stored on

a user's computer only for the current browsing session and the cookie is deleted from the

computer when the browsing software is closed).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teaching of Mitchell within the system of Paolucci as

modified because (a) Paolucci teaches providing an automated secured access to a target

location (i.e. internet website) by launching of the process from a user's CD at the client site and

authenticating with the target system for the open session connection (Paolucci : Page 2 Line 1

– 2 and Page 6, 5th Bullet), and (b) Mitchell teaches using a temporary session cookie to be

stored on a user's computer so that the user does not have to repeatedly resubmit information

to the website and the cookie is valid only for the current browsing session and is deleted when

the browsing session is closed to avoid the abuse of the user's privacy by the untrustworthy

website (Mitchell: Column 1 Line 28 – 35 / Line 43 – 45 / Line 56 – 60 / Line 61 – 67).
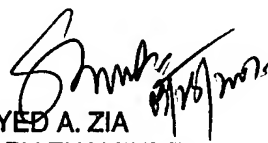
Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

SYED A. ZIA

PRIMARY EXAMINER

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Longbit Chai
Examiner
Art Unit 2131

LBC